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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,898	08/07/2003	Chantal Amalric	03129CIP	7792

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EXAMINER

LAMM, MARINA

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 07/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/635,898	Applicant(s) AMALRIC ET AL.	
	Examiner Marina Lamm	Art Unit 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/19/04</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claims 1-18 are pending in this application filed 8/7/03 which is a CIP of SN 10/220,296 filed 9/12/02.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-29 of copending Application No. 10/220,296 ('296). An obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but an examined application claim is not patentably distinct from the reference claim(s) because the examined claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985). Although the conflicting claims are not identical, they

are not patentably distinct from each other because claims 1-12 are generic to all that is recited in claims 1-29 of '296. That is, Claims 1-29 of '296 fall entirely within the scope of claims 1-12 of the instant invention, or, in other words, Claims 1-12 are anticipated by Claims 1-29 of '296. Specifically, both sets of claims recite to a topical composition containing an emulsifier, an oily outer phase and two aqueous inner phases, one of said inner phase being a gel.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 2, 4, 9, 16 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to

whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claims 2, 4, 9, 16 and 17 recite the broad recitation of the concentration range, and the claims also recite "preferably...." which is the narrower statement of the range.

6. Claim 17 recites the limitation "polymer" in line 1. There is insufficient antecedent basis for this limitation in the claim because Claim 13 does not recite any polymers.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-4 and 7-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Lahanas et al. (US 5,304,334).

Lahanas et al. teach topical multiphase compositions for the use in skin cosmetic formulations, comprising water phase and hydrophilic gel phase dispersed in a continuous phase of a silicone oil. See Abstract, Figure 1. The compositions of Lahanas et al. contain 10-20% of silicone oil, 20-30% of hydrophilic gel phase, 2-5% of gelling

polymer and 3-8% of primary emulsifier. See Examples Two and Three. The compositions of the reference are prepared by mixing primary water-in-silicone emulsion with separately prepared hydrophilic gel to provide a dispersion in which the gel is dispersed in the water-in-silicone emulsion. See Example Two. The claimed viscosity of the gel is inherent in the reference because the reference teaches the same gelling polymers as disclosed herein employed in the same or similar concentrations.

Thus, Lahanas et al. teach each and every limitation of Claims 1-4 and 7-12.

9. Claims 1-3, 6-13 and 16-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Briggs et al. (WO 96/04894), supplied by the Applicant.

Briggs et al. teach multiple cosmetic emulsions, containing an oily outer phase and two or more aqueous inner phases, wherein one of these aqueous phases can be in the form of a gel, containing gelling agent such as xanthan gum. See p. 7, second paragraph; p. 14, last paragraph; p. 15; Examples III and IV. The suitable outer phase oils of Briggs et al. include silicone oils, waxes, dicaprylate/dicaprate, isopropyl palmitate, etc and are present at the claimed concentrations. See p. 7; pp. 15-16; Examples. Briggs et al. teach preparing the emulsions by first preparing water and oil emulsion and then adding to the emulsions a gel phase. See Examples III and IV. The compositions of Briggs et al. may contain 1-12% of sunscreens, such as titanium dioxide, zinc oxide and/or organic sunscreen. See pp. 12, 16; Example IV. The compositions of Briggs et al. also contain mineral fillers such as talc. See Example IV.

Thus, Briggs et al. teach each and every limitation of Claims 1-3, 6-13 and 16-18.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lahanas et al.

Lahanas et al. applied as above. While teaching mixing primary water-in-silicone emulsion with separately prepared hydrophilic gel, the reference does not explicitly teach whether the primary emulsion is introduced into the gel or the gel is introduced into the primary emulsion as claimed in the instant claims. However, there appears to be no criticality associated with the claimed order of mixing the ingredients because the prior art achieves the same results (i.e. preparing a dispersion in which the aqueous gel is dispersed in the water-in-oil emulsion) as claimed herein. Therefore, in the absence of some evidence of unexpected results due solely to the mixing ingredients in the specific order, it would have been obvious to one having ordinary skill in the art at the time of the invention to mix the primary emulsion and the gel in any order, because the prior art derives the same result as discussed above.

12. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Briggs et al.

Briggs et al. applied as above. While the references do not explicitly teach the claimed ratio of Claim 4, it is the Examiner's opinion that the determination of optimal or workable ratio of the primary emulsion to the gel phase by routine experimentation is obvious absent showing of criticality of the claimed ratio. One having ordinary skill in the art would have been motivated to do this to obtain the desired moisturizing properties of the composition. With respect to Claim 5, the reference does not explicitly teach introducing the primary emulsion into the gel. However, there appears to be no criticality associated with the claimed order of mixing the ingredients because the prior art achieves the same results (i.e. preparing a dispersion in which the aqueous gel is dispersed in the water-in-oil emulsion) as claimed herein. Therefore, in the absence of some evidence of unexpected results due solely to the mixing ingredients in the specific order, it would have been obvious to one having ordinary skill in the art at the time of the invention to mix the primary emulsion and the gel in any order, because the prior art derives the same result as discussed above.

13. Claims 13 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lahanas et al. in view of Briggs et al.

Lahanas et al. applied as above. The reference does not teach the sunscreens of the instant claims. Further, the reference does not teach mineral fillers of Claim 18. However, Briggs et al. teach multiphase emulsions containing 1-12% of UV absorbing

agents as well as mineral fillers (matte finishing agents) such as talc, mica, etc. See above and p. 11, last paragraph. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the cosmetic emulsions of Lahanas et al. such that to employ sunscreen agents and/or mineral fillers for their art-recognized purpose. One having ordinary skill in the art would have been motivated to do this to obtain UV protectant and/or mattifying effect as suggested by Briggs et al.

14. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over either (a) Briggs et al. in view of either Ansmann et al. (US 5,840,943) or Milius et al. (WO 00/56438 as translated by US 6,488,946) or (b) Lahanas et al. in view of Briggs et al. and further in view of either Ansmann et al. or Milius et al.

a. Briggs et al. in view of either Ansmann et al. or Milius et al.

Briggs et al. applied as above. The reference does not explicitly teach the claimed emulsifiers. However, Ansmann et al. teach making stable emulsions using polyglycerol polyhydroxystarate emulsifiers in combination with other conventional w/o emulsifiers, including polyglycosides. See Abstract; col. 5, lines 5-13, 66-67; col. 6, lines 1-2. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the emulsions of Briggs et al. such that to employ the emulsifiers of Ansmann et al. One having ordinary skill in the art would have been motivated to do this to obtain improved stability as suggested by Ansmann et al. The selection of a known material based on its suitability for its intended use is obvious absent a clear showing of unexpected results attributable to the applicant's specific

selection. See e.g., *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).

Alternatively, Milius et al. teach using polyglycoside emulsifiers for making stable w/o emulsions. See Abstract. The emulsifiers of Milius et al. can be employed in combination with co-emulsifiers such as polyglycol polyhydroxystearates and silicone emulsifiers. See col. 4, lines 45-51. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the emulsions of Briggs et al. such that to employ the emulsifiers of Milius et al. One having ordinary skill in the art would have been motivated to do this to obtain improved stability as suggested by Milius et al.

b. Lahanas et al. in view of Briggs et al. and further in view of either Ansmann et al. or Milius et al.

Lahanas et al. in view of Briggs et al. applied as above. Neither reference teaches the claimed emulsifiers. However, either Ansmann et al. or Milius et al. above teach using the claimed emulsifiers for obtaining w/o emulsions having improved stability. See above. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the emulsions of Lahanas et al. such that to employ the emulsifiers of either Ansmann et al. or Milius et al. One having ordinary skill in the art would have been motivated to do this to obtain improved stability as suggested by Ansmann et al. or Milius et al.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 5,332,595; US 5,798,108.

16. No claim is allowed at this time.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Lamm whose telephone number is (571) 272-0618. The examiner can normally be reached on Mon-Fri from 11am to 5pm.

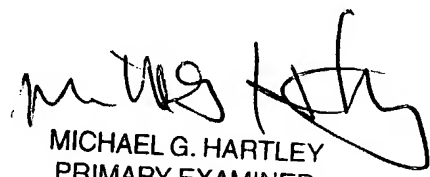
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached at (571) 272-0887.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ml

7/2/04


MICHAEL G. HARTLEY
PRIMARY EXAMINER